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09/971,976	10/04/2001	Richard Lawn	32136191.10	5692

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BAKER & MCKENZIE  
PATENT DEPARTMENT  
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EXAMINER

RODRIGUEZ, PAUL L

ART UNIT

PAPER NUMBER

2125

DATE MAILED: 03/26/2004

16

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/971,976

Applicant(s)

LAWN ET AL.

Examiner

Paul L. Rodriguez

Art Unit

2125

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 06 February 2004.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 7-16 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 7-16 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.  
10) ☒ The drawing(s) filed on 04 October 2001 and 08 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 15.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

1. The amendment filed 2/6/04 has been received and considered. Claims 7-16 are presented for examination.

#### ***Continued Examination Under 37 CFR 1.114***

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 2/6/04 has been entered.

#### ***Claim Objections***

3. Claims 7, 9, 11 and 12 are objected to because of the following informalities:

Claim 7 lines 1-2 states "...providing access to coloring algorithms to a user", awkward language, would be better as "...providing a user access to coloring..."

Claim 7 line 3 states "a a server..."

Claim 7 line 4 states "...the optimization of each of a..." would be better as "...an optimal use of each...", "...an optimum use of each..." or "...an optimized use of..."

Claim 7 line 10 states "...to provide access to the information to the user via...", awkward language, would be better as "...to provide the user access to the information via..."

Claim 7 lines 11-12 states "selection of at least one of...by the user based...", awkward language, would be better as "selection by the user of at least one...algorithm based..."

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Claim 7 lines 12-13 states "...by the user...by the user", would be better if the "by the user" on line 12 was removed, appears redundant.

Claim 9 line 3 states "...providing access to...to the user." would be better as "...providing the user access to..."

Claim 11 line 2 refers to "a selected one of the", previously "selection of at least one..." was already recited, unclear if this is referring to a separate and distinct selection.

Claim 12 line 3 states "...algorithm developers information...", would be better as "algorithm developers, information..."

Claim 12 line 4 states "...the optimization of each of a..." would be better as "...an optimal use of each...", "...an optimum use of each..." or "...an optimized use of..."

Appropriate correction is required.

4. The examiner has provided a number of examples of the claim deficiencies in the above, however, the list of deficiencies may not be all inclusive. Applicant should refer to these as examples of deficiencies and should make all the necessary corrections to eliminate the claim objections.

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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Claims 7-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

6. Claim 7 recites the limitation "the optimization" in line 4. There is insufficient antecedent basis for this limitation in the claim.

7. Claim 7 recites the limitation "the selection" in line 11. There is insufficient antecedent basis for this limitation in the claim.

8. Claim 12 recites the limitation "the optimization" in line 4. There is insufficient antecedent basis for this limitation in the claim.

9. Claim 12 is rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential elements, such omission amounting to a gap between the elements. See MPEP § 2172.01. The omitted elements are related to the limitations of "providing the information to a user via a client computer" and "receiving a selection of...from the user". The method claim fails to provide adequate connection between essential elements. The providing limitation does not disclose from which elements the information is provided, this is unclear because the claim previously received the information in a server and stored the information in a database. It is also unclear where the "selection" step is performed, either at the server, database or client computer.

10. Due to the vagueness and a lack of a clear definition of the terminology and phrases used in the specification and claims, the claims have been treated on their merits as best understood by the examiner.

*Claim Rejections - 35 USC § 103*

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

12. Claims 7-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yon et al (U.S. Pat 6,507,824) in view of Chan (U.S. Pat 6,342,952).

Yon et al teaches (claim 7) an algorithm exchange (figure 1, col. 2 lines 26-38, col. 4 lines 26-41) for providing access to coloring algorithms to a user (col. 1 lines 40-62, col. 2 lines

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25-55), said algorithm exchange comprising a server (reference number 20) configured to receive from at least one algorithm developer information (col. 2 line 56 – col. 3 line 23), a database coupled to the server and configured to store the information, (reference number 16, 35, 37, col. 2 lines 23-33), and wherein the server is further configured to provide access to the information to the user via a client computer associated with the server (reference numbers 18a-d), and to facilitate the selection of at least one of the plurality of coloring algorithms by the user based on the information and a particular application provided by the user (col. 3 lines 24-34), (claim 8) wherein the server is configured to receive the selected at least one of the plurality of coloring algorithms, and further configured to provide the selected at least one of the plurality of coloring algorithms to the user (col. 2 line 25 – col. 3 line 34), (claim 9) wherein the server further comprises a computer readable medium (col. 8 lines 13-32) for storing a script program (col. 8 lines 3-21), said script program providing access to the plurality of coloring algorithms to the user (col. 2 lines 39-50, col. 8 lines 3-11), (claim 10) wherein the server is further adapted to receive at least one color measurement from the client computer (col. 3 line 45 – col. 4 line 25) and the database is further adapted for storing the received at least one color measurement (col. 3 line 45 – col. 4 line 25, col. 6 line 63 – col. 7 line 12,), (claim 11) wherein the at least one color measurement is used as an input to a selected one of the at least one of the plurality of coloring algorithms for providing resulting color data to the client computer from the server (col. 3 line 65 – col. 4 line 25), (claim 12) a method for selecting a coloring algorithm (col. 3 lines 14-23), said method comprising receiving in a server from at least one algorithm developer information regarding the plurality of coloring algorithms for color recommendations (col. 2 lines 30-33, col. 3 lines 14-34), storing the information in a database associated with the server (col. 2 lines 30-

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34), providing the information to a user via a client computer (figures 2-5, col. 2 lines 56-67), and receiving a selection of at least one of the plurality of coloring algorithms from the user based on the information and a particular application provided by the user (col. 3 lines 24-34), (claim 13) further comprising receiving at least one color measurement from the user via the client computer for user as an input to the selected at least one of the plurality of coloring algorithms for providing resulting color data to the client computer (col. 3 line 45 – col. 5 line 28), (claim 14) further comprising storing the at least one color measurement in the database (col. 3 line 45 – col. 4 line 25, col. 6 line 63 – col. 7 line 12), (claim 15) further comprising receiving at least one of the plurality of coloring algorithms by the server, and storing the received at least one of the plurality of coloring algorithms in the database (col. 3 lines 29-34, col. 7 lines 51-62) and (claim 16) further comprising receiving the selected at least one of the plurality of coloring algorithms at the server (reference number 16) and providing the selected at least one of the plurality of coloring algorithms to the user (col. 3 lines 24-34).

Yon et al fails to teach receiving from at least one algorithm developer information regarding the optimization of each of a plurality of coloring algorithms for substrate type, color recommendations, or colorant type.

Chan teaches an algorithm exchange for providing access to coloring algorithms to a user (figure 1), said algorithm exchange comprising a server (reference number 10), configured to receive from at least one algorithm developer information regarding the optimization of each of a plurality of coloring algorithms for substrate type, color recommendations, or colorant type (col. 13 lines 13-55, col. 7 line 50 – col. 8 line 18), a database coupled to the server and configured to store the information (reference number 22, software C), and wherein the server is further



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configured to provide access to the information to the user via a client computer (reference number 4, figure 1).

Yon et al and Chan are analogous art because they are both related to selecting or matching colors using client server architecture.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize the optimization, and substrate types of Chan in the method and system of Yon et al because Chan teaches a computer based system with remote access, capable of identifying a desired color and a formulation for matching and mixing the color (col. 2 lines 3-17), Chan also teaches that the time needed to match, produce and ship the color to the customer is greatly reduced and teaches a system that enhances the ability to match a customer color and meet customer demands (col. 8 lines 19-45).

### ***Response to Arguments***

13. Applicant's arguments with respect to claims 7-16 have been considered but are moot in view of the new ground(s) of rejection.

Applicant's arguments with respect to the rejection under 35 USC § 112 have been fully considered but are not persuasive. Applicant's amendment of the claims has introduced new claim objections and 112 rejections. The amendment also failed to provide a connection between the essential elements of claim 12 and the rejections remain.

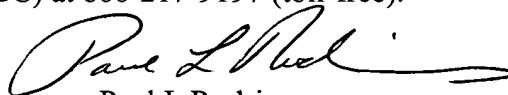
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*Conclusion*

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul L Rodriguez whose telephone number is (703) 305-7399. The examiner can normally be reached on 6:00 - 4:30 T-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Leo P Picard can be reached on (703) 308-0538. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Paul L Rodriguez  
Examiner  
Art Unit 2125

PLR  
3/25/04